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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,805	10/01/2001	Darrell T. McKenzie	DANA-139	3400

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EXAMINER

CECIL, TERRY K

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 10/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,805

Applicant(s)

MCKENZIE, DARRELL T.

Examiner

Mr. Terry K. Cecil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2001 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

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DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed **terminal disclaimer** in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5 and 8-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6-9, and 12 of copending Application No. 09/901,632 in view of Daniel (U.S. 5,250,176). The aforementioned claims of application number '632 includes all the limitations of the aforementioned claims of the instant application with the exception of the clean-side valve. However, Daniel teaches a clean side valve 41 (shown in figure 1) as a unit with anti-drainback and bypass valves. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the clean-side valve of Daniel in the invention of copending Application No. 09/901,632, since Daniel teaches the benefit of avoiding leakage of clean oil from the filter upon shutdown of the engine (abstract). This is a provisional obviousness-type double patenting rejection.

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Specification

3. The abstract is objected to because it is too long (greater than 150 words). Appropriate correction is required.

Drawings

4. The drawings are objected to because of the following reasons:
- The following reference signs mentioned in the disclosure are not shown in the drawings:
“43” (page 5). See 37 CFR 1.84(p)(5).
 - In figure 2, the leader for reference no. 101 should indicate the intersection of lip edges 108 and 110, as described on page 7 in the specification.

Applicant is required to submit a proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. Objections to the drawings will not be held in abeyance.

Claim Objections

5. Claims 1-8 and 11 are objected to because of the following informalities: “or” should be “for” (claim 1, line 1); “value” should be “valve” (claim 2, line 4); “and valve” should be added after “support” (in the preambles in each of claims 3-7) to maintain consistency with the preambles of claims 1 and 2; “transversely” has been misspelled (claim 3, line 2); “the” should be added before “clean side valve” (claim 4, line 1); “an” should be added before “annular” (claim 8, line 2), “a” should be added before “central” (claim 8, line 4); before “annular”, “a” should be “an” (claim 8, line 15); “an” should be added before “annular” (claim 11, line 2); “a”

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should be added before "central" (claim 11, line 5); and "a" should be "an", before "annular" (claim 11, line 15). Appropriate correction is required.

Claim Rejections - 35 USC ' 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are rejected because of the following reasons:

- the following terms lack antecedent basis: "valve member" (claim 5); "the one valve" (claim 7, line 4, did applicant intend to claim "the one way valve"?); "the first section" (line 25 in each of claims 8 and 11, did applicant intend to claim "the first *annular* section"?); "the body member" (line 25 in each of claims 8 and 11, did applicant intend to claim "the unitary body"?); "the valve body" (line 28 in each of claims 8 and 11); and "the flexible resilient material" (claim 15);
- in claim 2, line 4 (first occurrence) and also line 5, "aligned" is indefinite because it is unclear with what structures the second annular section and the flange portion are aligned;
- in line 5 in each of claims 8 and 11, describing the radial openings to be "spaced a fixed radial distance from one another" is unclear since applicant's radial openings 19 are each radially spaced from the central opening but equidistantly spaced from one another (adjacent openings);

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- in line 11, in each of claims 8 and 11, "less than radial distances between the radial openings" is unclear: did applicant intend to claim "less the diameter of the area circumscribed by the radial openings"?; and
- claims 3-7, 8-10 and 12-15 are rejected since they suffer as the claims from which they depend.

Claim Rejections - 35 USC ' 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Daniel (U.S. 5,250,176). Daniel discloses a filter element support and valve comprising the following:

- a valve body (the combination of 40 and 24) unitary with a bypass valve portion 50, an anti-drainback portion 24, and a clean side valve shown at the top of figure 3 (*see the examiner's note on page 7*)[as in claim 1];
- a filter element 30 having a hollow core 34, wherein the valve portions of the unitary body include annular sections aligned (coaxial) with the hollow core (as shown in figure 1); wherein one of the annular sections includes a bypass valve 54; and wherein a radially extending flange 24 provides an anti-drainback valve [as in claim 2]; and

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- a clean-side valve in a plate section 68 which extends transversely across the annular sections [as in claims 3 and 4] and which is unitary with the valve [as in claim 5].

Claim Rejections - 35 USC ' 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.
Ascertaining the differences between the prior art and the claims at issue.
Resolving the level of ordinary skill in the pertinent art.
Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 6-7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel in view of Hultgren et al. (U.S. 3,369,666), hereinafter "Hultgren". Daniel, which teaches a clean-side one-way valve, has been expanded above. Claims 6-7 have the limitations of a clean-side one-way valve that is a purse valve opening away from the hollow core and which includes a pair of lips intersecting along a line. Hultgren teaches a clean-side one-way valve that is a purse valve [as in claim 6] opening away from the hollow core and which includes a pair of lips intersecting along a line (figure 2)[as in claim 7]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the clean-side

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valve of Hultgren as the clean side valve in Daniel, since Hultgren teaches the benefit of a tight seal that prevents leakage (col. 2, lines 45-50). As for claim 15, Daniel teaches a unitary body that includes rubber (portion 24 is made of rubber, *see the examiner's note below*).

Examiner's Note: the examiner considers the valves of Daniel to be unitary since they work together as a unit as shown in figure 1. The applicant has not defined "unitary" otherwise. If it was the applicant's intention to define the valve portions to all be part of an "integrally-molded unitary valve body of resilient flexible material", the examiner points out that such a concept is known in the art—e.g. Stack (U.S. 3,957,640). In Stack, the relief and anti-drainback valves are portions of the same integrally-molded unitary valve body of resilient flexible material having the benefits of design simplification and cost reduction (col. 1, lines 15-17). In view of Daniel, the examiner contends that also having a clean-side valve integral therewith would be within ordinary skill of the skilled man in the art. As for claim 15, it is pointed out that the claim does not require the entire valve body to be made of rubber but that such would be made obvious by Stack.

Allowable Subject Matter

12. Claims 8-14 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action.

13. The following is an examiner's statement of reasons for allowance: The closest cited art—Daniel—fails to anticipate or render obvious, alone or in any proper combination, the 3-

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valve unitary body that includes a radially extending flange having radially extending rib portions thereon that also extend axially on the first annular section but are axially spaced from the annular sealing ring which deflects inwardly when the filter element is clogged—within the inventions of claims 8 and 11.

14. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (703)305-0079 for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:00a to 4:30p, on at least four days during the week M-F.
- The group receptionist can be reached at (703)308-0661 for inquiries of a general nature or those relating to the status of this or proceeding applications.
- Wanda Walker, the examiner's supervisor, can be reached at (703)308-0457 if attempts to reach the examiner are unsuccessful.
- Fax numbers for this art unit are as follows:
 - i. (703)872-9310 for *official* faxes (i.e. faxes to be entered as part of the file history) that are not after-final; and
 - ii. (703)872-9311 if after-final.

TKC
October 29, 2002

Examiner Terry Cecil
A.U. 1723